

## **REMARKS**

### **I. Status and Disposition of the Claims**

In the instant application, claims 1-27 and 29-30, of which claims 1, 12, 23, 24, 25 and 30 are independent, are pending and under consideration on the merits.

In the Final Office Action<sup>1</sup> mailed February 4, 2008, the following actions were taken:

1) Claims 1-4, 6, 8-15, 17, 19-25, 29 and 30 were rejected under 35 U.S.C. 103(a) as being unpatentable over Pub. No. US 2004/0225507, by Smith et al. (herein after "*Smith*") in view of Pub. No. US 2008/0015959, by Kruglikov et al. (herein after "*Kruglikov*");

2) Claims 27 was rejected as being obvious over *Smith* in view of knowledge in the art; and

3) Claims 5, 7, 16, 18 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Smith* and *Kruglikov* further in view of Pub. No. US 2002/0019759 by Arunapuram et al. (hereinafter "*Arunapuram*").

In this Response to the Final Office Action, Applicant amends claims 1, 12, 23, 24, 25, 29 and 30.

### **II. Applicant is a Sole Inventor.**

In the Office Action, Applicant was advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. §103(c) and potential §102(e), (f) or (g) prior art under §103(a). However, the present Application does not name joint inventors. Applicant,

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Arno D. Bruns, is the sole inventor of the present Application. Therefore, further disclosure of claims ownership is unnecessary.

### III. Response to Rejections

In this Response to the Final Office Action, Applicant respectfully traverses the rejections listed above.

#### A. The Rejection of the Claims under 35 U.S.C. §103 is Improper.

In the Office Action, claims 1-4, 6, 8-15, 17, 19-25, 29 and 30 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Smith* in view of *Kruglikov*. Also, claim 27 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Smith* in view of knowledge in the art. Moreover, claims 5, 7, 16, 18 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Smith* and *Kruglikov* further in view of *Arunapuram*.

Applicant respectfully traverses the rejections of the claims under 35 U.S.C. §103(a) because a *prima facie* case of obviousness has not been established. "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007) held that “[t]here is no necessary inconsistency between the idea underlying the TSM [teaching, suggestion, motivation] test and the *Graham* analysis.” M.P.E.P. §2141 (rev. 6, Sept. 2007), citing *KSR* at 82 U.S.P.Q. 2d at 1396. Applicant understands this to mean that when applicable, as here, TSM reasoning may still be applied not only by an examiner but also by Applicant to refute a §103 rejection.

Here, a *prima facie* case of obviousness has not been established because the scope and content of the prior art has not been properly determined, nor have the differences between the claimed invention and the prior art been properly ascertained. Accordingly, a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art has not been clearly articulated.

**i. Claims 1-4, 6, 8-15, 17, 19-25, 29 and 30 are allowable.**

Claims 1-4, 6, 8-15, 17, 19-25, 29 and 30 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Smith* in view of *Kruglikov*. See Office Action, pages 2-4. In particular, the Office Action contains the assertion, “It would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify *Smith*, to include the availability date in determining the source location for the goods, in order to up to date delivery and inventory management information.” See Office Action at 3. Applicant respectfully disagrees with the assertion and traverses the rejection for at least the reasons stated below.

As discussed in detail below, a fair reading of *Smith* and *Kruglikov* reveal that the references fail to teach or suggest each and every element of amended claim 1. In addition, no additional evidence has been raised establishing a tenable rationale that one of ordinary skill would have been motivated to modify the references so as to arrive at the claimed invention.

In the present case, amended independent claim 1 recites, *inter alia*, “selecting a source location comprising an origin for the good based on an availability date of the good at the source location, the availability date being determined independently of the

requested delivery date." *Smith* does not teach, disclose or suggest this recited feature. The Office Action confirms this. See Office Action at 3.

*Kruglikov* fails to cure the deficiencies of *Smith*. That is, *Kruglikov* also fails to teach, disclose or suggest the above-recited feature either. The Office Action cites *Kruglikov's* Page 1, Figs. 5 and 6 and paragraphs 0052-0055 as teaching using scheduling goods based on availability and delivery date. See Office Action at 3. However, nowhere in these citations, or elsewhere in *Kruglikov*, is there a suggestion that the availability date at a source location is determined independently of the requested delivery date. Further, nowhere in these citations, or elsewhere in *Kruglikov*, is there a suggestion that the source location comprises the origin of the good, or that the source location is selected based on availability of the good at the source location.

Turning first to the availability date determination, *Kruglikov's* Abstract on page 1 discloses, "The availability information is calculated with reference to a delivery date, an available number of units, and a reserved number of units." Therefore, contrary to Applicant's system, in which the availability date is determined independently of the requested delivery date, *Kruglikov's* availability date is a function of the delivery date.

*Kruglikov's* Fig. 5 illustrates an ATP data table that stores the available quantity and the served quantity for each good. See *Kruglikov* at para. 0080. ATP is defined to be "available to promise." See *Kruglikov* at para. 0070. Availability information for a particular product is determined with reference to the selected delivery date and up-to-date inventory information. See *Kruglikov* at para. 0007. Therefore, as disclosed above with respect to *Kruglikov's* Abstract on page 1, the *Kruglikov* availability date is a function of the delivery date.

Turning next to the recitation in claim 1 of "selecting a source location", *Kruglikov* does not disclose selecting a source location. *Kruglikov's* Fig. 6 illustrates splitting an order in two if selected items are available from a vendor at different times. See *Kruglikov* at Fig. 6, elements 616, 618, 620. "[W]hen a user selects an item in the WS interface (602) and the user's cart has not been scheduled (604), the selected item and each additional selection are placed in the user's unscheduled cart (606 and 612). If the user has specified a delivery date (604) and the selected item is available on the

delivery date (608), the selected item and each additional selection satisfying this criterion are placed in the user's scheduled cart (606 and 612). If, on the other hand, the selected item is not available on the specified delivery date (608), the selected item is placed in a second unscheduled cart (610)." See *Kruglikov* at para. 0093. It can therefore be seen that *Kruglikov's* system reschedules the delivery date of the good when the good is not available at a vendor. *Kruglikov* does not choose a vendor among possible vendors. The *Kruglikov* vendor is given. Assuming *arguendo* that *Kruglikov's* "vendor" is the source location, it can be seen that *Kruglikov* does not select a source location.

*Kruglikov's* paragraphs 0052-0055 provide a high-level walkthrough of subsystem interactions relating to inventory inflow. However, the availability data disclosed in the cited paragraphs presents availability of items at the subsystems of *Kruglikov's* delivery management system, which are at mid-points and not at the origin of the goods. Assuming *arguendo* again that *Kruglikov's* "vendor" is the source location, *Kruglikov* paragraphs 0052-0055 do not disclose availability at a source location. Therefore, nowhere in these paragraphs is there a suggestion of selecting a source location based on the availability date of the order at the source location.

Because neither *Smith* nor *Kruglikov* disclose "selecting a source location comprising an origin for the good based on an availability date of the good at the source location, the availability date being determined independently of the requested delivery date," as recited in amended claim 1, the cited references fail to teach or suggest each and every element of claim 1.

Moreover, one of ordinary skill in the art would not find it obvious to modify the apparatus of *Smith*, using the teachings of *Kruglikov*, to achieve the required combination recited by claim 1. Applicant submits that while examiners may rely upon what is generally known in the art, they **must provide evidentiary proof** of that knowledge. See *In re Zurko*, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001) ("With respect to core factual findings in a determination of patentability . . . the Board cannot simply reach conclusions based on its own understanding or expertise . . . Rather, the Board

must point to some concrete evidence in the record in support of these findings.”) (emphasis is added).

Here, Applicant respectfully submits that the Office Action has not explained *why* or *how* one of ordinary skill would modify the apparatus of *Smith*, using the teachings of *Kruglikov*, so as to arrive at the claimed invention. In particular, the Office Action has not explained at least: (a) *why* one of ordinary skill would modify the steps of *Smith* so as to select a source location for the good based on the order’s availability date, which is determined independently of the requested delivery date, at the source location, which is the origin of the good; and, especially, (b) *how* one of ordinary skill would know to select and arrange the steps of *Smith* and *Kruglikov* so as to arrive at a system with the claimed feature of “selecting a source location comprising an origin for the good based on an availability date of the good at the source location, the availability date being determined independently of the requested delivery date”, as recited in amended claim 1.

The burden is on the Patent Office to provide some tenable rationale as to *why* and *how* one of ordinary skill in the art would combine *Smith* and *Kruglikov* so as to arrive at the presently claimed methods recited in claim 1. In the present case, however, no such rationale has been provided.

The Office Action contains an assertion that adding the feature of *Kruglikov* to the system of *Smith* is “in order to up to date delivery and inventory management information.” See Office Action at 3. At best, the position taken in the Office Action could be considered an assertion that the proposed modifications could be performed. However, “[t]he mere fact that a reference can be combined or modified does not render the resultant combination [or modification] obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01 (emphasis in original). Combining *Smith* and *Kruglikov* would not result in a predictable variation of Applicant’s invention because *Smith* and *Kruglikov* lack the elements recited in amended claim 1, namely “selecting a source location comprising an origin for the good based on an availability date of the good at the source location, the availability date being determined independently of the requested delivery date.”

Further, even assuming *arguendo* that the Office Action's assertion is correct, "up to date delivery and inventory management information" is not sufficient motivation for adding a step such as selecting a source location based on the availability date of the good at the source location, since availability information of a good at a source location is only one of several variables that could be considered for a goods delivery system. Further, determining the availability date of the good independent of the required delivery date is only another of several such variables. More input would be required before a desire to update delivery management and inventory management information would point to adding features such as "selecting a source location comprising an origin for the good based on an availability date of the good at the source location, the availability date being determined independently of the requested delivery date." Therefore, it misses the objective of the Applicant's system as recited in claim 1.

For at least these reasons, Applicant submits that the Office has not met the burdens necessary to establish that present claim 1 is obvious under § 103(a). Therefore the § 103(a) rejection of claim 1 is improper, and should be withdrawn.

For at least the reasons noted above, claims 12, 23, 24, 25 and 30 which recite similar elements and were rejected under the same rationale, and claims 2-4, 6, 8-11, 13-15, 17, 19-22 and 29 which depend directly or indirectly from claims 1, 12 and 25 are allowable under 35 U.S.C. 103(a). See Office Action at page 9.

**ii. Claim 27 is allowable.**

The rejection of claim 27 was based on official notice that rush orders are well known and therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify *Smith*, to have the user indicate the order is a rush order and schedule accordingly. Applicant respectfully disagrees with this assertion.

In the present case, claim 27 recites, *inter alia*, "receiving an instruction for planning the delivery of the order as a rush order, wherein planning comprises determining, selection and scheduling the trip forward from the availability date at the

source location.” See Office Action at 3-4. *Smith* does not teach, disclose or suggest this recited feature. The Office Action confirms this. See Office Action at 4.

Whether or not rush orders comprise an obvious feature, incorporating rush orders into *Smith* would not result in the invention recited in claim 27 as a whole. Claim 27 depends from claim 25, and thus includes all the elements and limitations thereof. As set forth above with respect to claim 1, which recite similar elements of claim 25, the feature “selecting a source location comprising an origin for the good based on an availability date of the good at the source location, the availability date being determined independently of the requested delivery date” is not found in *Smith*. Incorporating rush orders into the *Smith* system would not provide the *Smith* system with the ability to select source locations for goods based on the availability date of the goods at the source locations.

Moreover, one of ordinary skill in the art would not find it obvious to modify the apparatus of *Smith*, using teachings of the known art, to achieve the required combination recited by claim 27. Applicant submits that while examiners may rely upon what is generally known in the art, they **must provide some concrete evidence** in the record in support of findings.

Here, Applicant respectfully submits that the Office Action has not explained *why* or *how* one of ordinary skill would modify the apparatus of *Smith*, using the teachings of the known art, so as to arrive at the claimed invention. In particular, the Office Action does not explain at least: (a) *why* one of ordinary skill would modify the steps of *Smith* so as to “receiv[e] an instruction for planning the delivery of the order as a rush order, wherein planning comprises determining, selection and scheduling the trip forward from the availability date at the source location,” and, especially, (b) *how* one of ordinary skill would know to select and arrange the steps of *Smith* and the known art so as to arrive at the above-recited feature of amended claim 27.

The burden is on the Patent Office to provide some tenable rationale as to *why* and *how* one of ordinary skill in the art would combine *Smith* and the known art so as to arrive at the presently claimed methods recited in claim 27. In the present case, however, no such rationale has been provided.



At best, the position taken in the Office Action could be considered an assertion that the proposed modifications could be performed. However, "[t]he mere fact that a reference can be combined or modified does not render the resultant combination [or modification] obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01 (emphasis in original). Combining *Smith* and the known art would not result in a predictable variation of Applicant's invention because *Smith* and the known art lack the elements recited in amended claim 1, namely "determining, selecting and scheduling the trip forward from the availability date at the source location." As disclosed above, *Smith*'s system's does not select source locations based on availability date. It selects based on zip code and brand information of the requested goods identified from the order. See *Smith* at para. 0031. Selecting a source location based on availability of the good at the source location is not in *Smith* nor is having multiple potential source locations a necessary component of delivering rush orders. Selecting a source location for the good based on an availability date of the good at the source location would not be predictable from incorporating rush order delivery in the *Smith* system.

For at least these reasons, Applicant submits that the Office has not met the burdens necessary to establish that present claim 27 is obvious under § 103(a). Therefore the § 103(a) rejection of claim 27 is improper, and should be withdrawn.

**iii. Claims 5, 7, 16, 18 and 26 are allowable.**

Claims 5, 7, 16, 18 and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Smith* and *Kruglikov* in further view of *Arunapuram*. See Office Action, page 5. In particular, the Office Action contains the assertion, "It would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify *Smith*, to have the optimal trip selected, based on criteria, such as hazardous material and cost, as disclosed by *Arunapuram*, in order to provide an optimum solution on the customer's needs." See Office Action at 3. Applicant respectfully disagrees and traverses the rejection for at least the reasons stated below.

As discussed in detail below, a fair reading of *Smith* and *Kruglikov* and *Arunapuram* reveal that the references fail to teach or suggest each and every element of claims 5, 7, 16, 18 and 26. In addition, no additional evidence has been raised establishing a tenable rationale that one of ordinary skill would have been motivated to modify the references so as to arrive at the claimed invention.

In the present case, claims 5 and 7 recite, "the set of criteria comprises at least one criterion representative of dangerous goods," and "the set of criteria comprises at least one criterion representative of cost information." A system combining *Smith* and *Kruglikov* does not teach, disclose or suggest this recited feature. The Office Action confirms this for *Smith* (see Office Action at 5), but it is equally true for *Kruglikov*.

Whether or not *Arunapuram* teaches the elements of claims 5 and 7, incorporating hazardous material and cost criteria into the combination system of *Smith* and *Kruglikov* would not result in the invention recited in claims 5 and 7 as a whole. Claims 5 and 7 depend from claim 1 and thus include all the elements and limitations thereof. As set forth above with respect to claim 1, the feature, "selecting a source location comprising an origin for the good based on an availability date of the good at the source location, the availability date being determined independently of the requested delivery date", is not found in *Smith* and *Kruglikov*. *Arunapuram* also does not teach, disclose or suggest the above-recited feature of claim 1. The system in *Arunapuram* manages transportation operations by processing information related to the transportation of a good and produces transportation solutions based on this information. See *Arunapuram* at 16. However, nowhere in *Arunapuram* is there any suggestion of selecting a source location. Therefore, whether or not selecting a trip based on dangerous goods or cost information was disclosed in *Arunapuram*, incorporating these features into *Smith* and *Kruglikov* would not result in the invention recited in claims 5 and 7 as a whole. Incorporating dangerous goods or cost information criteria into a system combining *Smith* and *Kruglikov* would not provide the system with the ability to select source locations for goods based on the availability date of the goods at the source location.

Moreover, one of ordinary skill in the art would not find it obvious to modify the apparatus of the combination system of *Smith* and *Kruglikov*, using the teachings of the *Arunapuram* to achieve the required combination recited by claim 5 and 7. As noted above, Applicant submits that while examiners may rely upon what is generally known in the art, they **must provide some concrete evidence** in the record in support of findings.

Here, Applicant respectfully submits that the Office Action has not explained *why* or *how* one of ordinary skill would modify the apparatus of *Smith* and *Kruglikov* using the teachings of *Arunapuram*, so as to arrive at the claimed invention. In particular, the Office has not explained at least: (a) *why* one of ordinary skill would modify the steps of *Smith* and *Kruglikov* so as to select a trip from the set of trips based on dangerous goods and cost information; and, especially, (b) *how* one of ordinary skill would know to select and arrange the steps of *Smith* and *Kruglikov* and *Arunapuram* (in which best shipping mode is determined by carrier type, equipment, route, etc.) so as to arrive at the claimed feature of “the set of criteria comprises at least one criterion representative of dangerous goods,” and “the set of criteria comprises at least one criterion representative of cost information,” as recited in claims 5 and 7.

The burden is on the Patent Office to provide some tenable rationale as to *why* and *how* one of ordinary skill in the art would combine *Smith* and *Kruglikov* and *Arunapuram* so as to arrive at the presently claimed methods recited in claims 5 and 7. In the present case, however, no such rationale has been provided.

The Office Action contains an assertion that adding the feature of *Arunapuram* to in a system combining *Smith* and *Kruglikov* is “in order to provide an optimum solution based on the customer’s needs.” See Office Action at 5. At best, the position taken in the Office Action could be considered an assertion that the proposed modifications could be performed. However, “[t]he mere fact that a reference can be combined or modified does not render the resultant combination [or modification] obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01 (emphasis in original). Combining *Smith* and *Kruglikov* and *Arunapuram* would not result in a predictable variation of Applicant’s invention because *Smith* and

*Kruglikov* and *Arunapuram* require additional information regarding the availability date of the good at the source location to be able to select a source location for the goods ordered. Further, even assuming *arguendo* that the assertion is correct that a system combining *Smith* and *Arunapuram* provides an optimum solution based on the customer's needs, it still does not result in a predictable variation of Application's invention since selecting a source location based on availability of the good at the source location is not a part of any of the systems disclosed in these references. Therefore, it misses the objective of the Applicant's system, which discloses "selecting a source location for the good based on the availability date of the order at the source location."

For at least this reason, a *prima facie* case of obviousness with respect to claims 5 and 7 have not been proved. The rejection of claims 5 and 7 under 35 U.S.C. §103(a) as being obvious from *Smith* in view of *Arunapuram* is thus improper and should be withdrawn.

For at least the reasons noted above, claims 16, 18 and 26, which recite similar elements rejected under the same rationale, are allowable under 35 U.S.C. §103(a). See Office Action at 4.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the reconsideration of the final status of the Office Action, the entry of this Amendment, the reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated:

May 5, 2008

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